

# **Interview Summary**

Application No.

09/160,991

Applicant(s)

CHERNG ET AL.

Examiner

Hwei-Siu C. Payer

Art Unit

3724

All participants (applicant, applicant's representative, PTO personnel):

(1) Hwei-Siu C. Payer.

(3) \_\_\_\_\_.

(2) Kristi Davidson.

(4) \_\_\_\_\_.

Date of Interview: 13 June 2002.

Type: a) ☐ Telephonic b) ☐ Video Conference

c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☒ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1-22, 24-27 and 29-<sup>31</sup>~~31~~.

Identification of prior art discussed: Baker (U.S. Patent No. 3,952,179) and Maybon (U.S. Patent No. 5,580,472).

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Hwei-Siu Payer  
Primary Examiner

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Hwei-Siu Payer  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

#### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

##### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

Ms. Davidson argues that Maybon '472 shows resurfacing the tops of the ridges on a refining plate and does not teach ridge or blade forming on a body surface from different material than the body. Examiner would like to point out the primary reference Baker '179 clearly shows die blades formed on a die body from different material than the die body as claimed. The difference between Baker and the claimed invention resides in the heat source used for cladding the blade material onto the body surface to form the blades. Specifically, Baker uses welding for cladding the hard blade material onto the less harder die body while the claimed invention calls for cladding by means of laser. However, cladding a harder material onto a less harder tool body by use of laser as heat source is known in the art as evidenced by the Maybon reference.

Ms. Davidson further argues the Baker patent is directed to cutting dies, whereas the Maybon patent is directed to paper pulp defibering and refining plates. The patents are non-analogous. In response, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we must decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171, 174. In this case, both Baker and Maybon references are relating to cladding a harder material onto a less harder body to form a working tip to be performed on a workpiece. It is clearly pertinent to the particular problem with which the inventor was involved.

The affidavit of Paul S. Madill under 37 C.F.R. 1.132 is given very little probative value for the following reasons:

- (1) Mr. Madill has not established there was a commercial success because he did not give competitive figures for sales for the entire market.
- (2) Mr. Madill has failed to establish the nexus between the commercial success and the inventive features because he does not carry his burden under the standard setup in In re Caveney. "In In re Caveney, the Court, in an opinion by Judge Rich, held that a nexus vis-a-vis the commercial success of the wiring duct there at issue was not adequately demonstrated where four out of five proclaimed advantages of the invention were also presented in the prior art devices. The Court decided that the commercial success may well be due to those features (the features found in the prior art)." 386 F.2d 917, 922-23, 155 USPQ 681 (CCPA 1967). All three advantages (laminated structure, relatively small size, and apertured configuration) Applicant is relied on are shown in the prior art devices (Calavetta and Domo).
- (3) Mr. Madill has not shown under the standard set forth in In re Heldt (433 F. 2d 808, 812-13, 167 USPQ 676 (CCPA 1970). Applicant must show that commercial success alleged is not due to other factors such as promotion, advertising, ect.

The affidavit of Gregg Harrison is given very little probative value for the following reasons:

- (1) Mr. Harrison merely provides a statement alleging an increase die life of the present invention.
- (2) The affidavit fails to demonstrate unexpected results or properties.
- (3) The affidavit fails to compare the closest prior art relied upon and the claimed invention under identical conditions except for the novel features of the invention. In re Brown, 173 USPQ 685; In re Chapman, 148 USPQ 711.

It is noted the affidavit of Mr. Graham Bell has not been received or has been missing from the file. No comment on the content of Mr. Bell's affidavit.

The interview was concluded in view of Ms. Davidson's difference of opinion not seen as moving the case.

A copy of Mr. Bell's affidavit has been placed in the file along with this Interview Summary.



July 3, 2001

Hwei-Sui Payer, Examiner  
Assistant Commissioner for Patents

Dear Examiner Payer,

My name is Graham Bell and I am an employee of Shorewood Packaging. I am in charge of the Rotary Die Department in Smiths Falls and have worked with rotary dies for over 20 years. We are currently using rotary cutting dies utilizing Bernal's laser cladding process die on slides and outers configuration. These cutting dies produced by Bernal Technologies are superior to other cutting dies we are currently using. With these dies, we have experienced a significantly longer life than with any other cutting dies. The time and cost to repair these dies is very high and longer life dies result in more output for our facility. The repair operation thus not only causes down time in the plant to switch the dies, but also causes a great deal of time and cost to transport and repair the dies. With the new cladded dies provided by Bernal Technologies, we have experienced a wear life of the die blades that is many times greater than dies we have previously used. The frequency with which we must endure the loss of productivity of the plant and the expense and time of transporting and cutting dies has been significantly reduced. The longer useful life of the blades translates into huge cost savings for our plant. In my opinion, this die represents a significant advancement in cutting die technology.

This declaration is not to be used for any advertisement, endorsement or publications, and is used solely for use in establishing patent ability.

Sincerely,

A handwritten signature in black ink, appearing to read "Graham Bell". The signature is fluid and cursive, with a large, sweeping loop at the end.

Graham Bell  
Maintenance Foreman

Serial No: 09/160,991  
Atty.Docket: BERL-18A